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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/742,124	12/22/2000	Kazunori Arima	862.C2075	7920

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EXAMINER

USTARIS, JOSEPH G

ART UNIT PAPER NUMBER

2623

DATE MAILED: 12/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/742,124	<b>Applicant(s)</b> ARIMA, KAZUNORI	
	<b>Examiner</b> Joseph G. Ustaris	<b>Art Unit</b> 2623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 20 September 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-50 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-50 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 28 August 2006 has been entered.

Claims 1-50 are pending. Claims 1-4, 19-24, 37, and 38 are amended.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-14, 15-28, 35-42, 49, and 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jones et al. (US005978013A) in view of Tanaka et al. (US006588012B2).

Regarding claim 1, Jones et al. (Jones) discloses a digital broadcast receiving apparatus (See Figs. 7 and 10; col. 3 lines 42-57) comprising:

means for receiving a digital broadcast of the program (e.g. advertising programming) (See Fig. 7, tv tuner 221; col. 3 lines 42-57 and col. 13 lines 4-7);

judging means for judging whether or not the received digital broadcast (e.g. advertising programming) includes information related to the set partial content (e.g. coupon information) (See Fig. 7, processor 224; col. 14 lines 1-16);

means for extracting the information when said judging means judges that the received digital broadcast includes the information (See Fig. 7, WST decoder 222; col. 14 lines 1-16);

printing means for print-outputting the extracted information (e.g. coupon information) without intervention of a user while receiving the digital broadcast (See Figs. 7 and 10, printer 244; col. 17 lines 20-40).

However, Jones does not disclose a means for setting a digital broadcast program and partial contents provided in the program, in advance.

Tanaka et al. (Tanaka) discloses a combination terminal unit that receives various signals such as CATV signals. The combination terminal unit allows users to reserve/schedule a TV program or "means for setting a digital broadcast program" and the type of topics of the TV program or "partial contents provided in the program" the user wishes to receive, in advance (See Fig. 3, 4, 15, 16 "Alert Screen", and 18; column 5 lines 10-20 and 36-45). Inherently thereafter, the terminal receives the TV program and topics "related to the set partial contents" and offers the user the option to record the TV program. Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify the digital broadcast receiving apparatus disclosed by Jones to perform a means for setting a digital broadcast program and partial contents provided in the program, in advance, as taught by Tanaka,

in order to provide a means of alerting or reminding the user of TV programs that are of interest to the user thereby providing more convenience for the user.

Claim 2 contains the limitations of claim 1 (wherein the digital broadcast receiving apparatus has an “output means” to transfer data to the printer (See Jones Fig. 7)) and is analyzed as previously discussed with respect to that claim.

Claim 3 contains the limitations of claim 1 and is analyzed as previously discussed with respect to that claim. Jones in view of Tanaka further discloses that the digital broadcast receiving apparatus has a “designation means” that allows a digital broadcast receiving apparatus to “designate print-output of information” (See Jones column 17 lines 25-33). Furthermore, Jones in view of Tanaka discloses a “means for receiving the digital broadcast of the designated program at the next and subsequent broadcast times” (See Tanaka Fig. 16, wherein the Alert screen notifies the viewer that the scheduled TV program will begin at the next and subsequent broadcast time). The supplemental data or “partial contents” is then printed or “means for performing print-output of the extracted information” (See Jones column 17 lines 25-33).

Claim 4 contains the limitations of claim 3 (wherein the digital broadcast receiving apparatus has an “means for outputting” to transfer data to the printer (See Jones Fig. 7)) and is analyzed as previously discussed with respect to that claim.

Regarding claim 5, the system stores “the designation into said storage means only in accordance with a designation from an operator” (See Jones column 15 line 62 – column 16 line 8).

Claim 6 contains the limitations of claims 4 and 5 and is analyzed as previously discussed with respect to those claims.

Regarding claim 7, the system is able to determine if printing the coupon is allowed or “means for judging whether or not print-output of the extracted information is permitted” and prohibits printing the coupon if it had been printed before or “means for prohibiting print-output of the extracted information if the print-output is not permitted” (See Jones column 14 line 37 – column 15 line 5; column 16 lines 9-24).

Claim 8 contains the limitations of claims 2 and 7 and is analyzed as previously discussed with respect to those claims.

Claim 9 contains the limitations of claims 3 and 7 and is analyzed as previously discussed with respect to those claims.

Claim 10 contains the limitations of claims 4 and 7 and is analyzed as previously discussed with respect to those claims.

Claim 11 contains the limitations of claim 7 (wherein the coupon information or “extracted information” includes coupon data or “information part” where the subscribers unit is able to determine if printing the coupon is allowed and to prevent printing if its not allowed) and is analyzed as previously discussed with respect to that claim.

Claim 12 contains the limitations of claims 2 and 11 and is analyzed as previously discussed with respect to those claims.

Claim 13 contains the limitations of claims 3 and 11 and is analyzed as previously discussed with respect to those claims.

Claim 14 contains the limitations of claims 4 and 11 and is analyzed as previously discussed with respect to those claims.

Regarding claim 15, Jones in view of Tanaka does not disclose a “means for judging whether or not said printing means is in a normal status and means for storing said information if said printing means is not in the normal status”.

Official Notice is taken that it is well known to check the status of a printer and to store the print job if the printer is not available. Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify the cable converter box, tuner, signal processor, and printer disclosed by Jones in view of Tanaka to include a means for checking if the printer is in “normal status” and to store the print job or also known as “extracted information” if the printer is not available or “not in the normal status” in order to ensure that the “information” is successfully printed or that the “extracted information” is not lost or erased if the printer is not available.

Claim 16 contains the limitations of claims 2 and 15 and is analyzed as previously discussed with respect to those claims.

Claim 17 contains the limitations of claims 3 and 15 and is analyzed as previously discussed with respect to those claims.

Claim 18 contains the limitations of claims 4 and 15 and is analyzed as previously discussed with respect to those claims.

Claim 19 contains the limitations of claim 1 (wherein the system performs the method) and is analyzed as previously discussed with respect to that claim.

Claim 20 contains the limitations of claim 3 (wherein the system performs the method) and is analyzed as previously discussed with respect to that claim.

Claim 21 contains the limitations of claim 1 (where inherently the system and system components are run by “computer programs”) and is analyzed as previously discussed with respect to that claim.

Claim 22 contains the limitations of claim 3 (where inherently the system and system components are run by “computer programs”) and is analyzed as previously discussed with respect to that claim.

Claim 23 contains the limitations of claim 2 (where the system includes a “transmitting apparatus” (See Jones Fig. 6)) and is analyzed as previously discussed with respect to that claim.

Claim 24 contains the limitations of claim 4 (where the system includes a “transmitting apparatus” (See Jones Fig. 6)) and is analyzed as previously discussed with respect to that claim.

Claim 25 contains the limitations of claims 7 and 23 (wherein the “information” is encoded in digital form within the television signal or “provided in a digital broadcast program” (See Jones col. 3 lines 42-57)) and is analyzed as previously discussed with respect to those claims.

Claim 26 contains the limitations of claims 7 and 24 (wherein the “information” is encoded in digital form within the television signal or “provided in a digital broadcast program” (See Jones col. 3 lines 42-57)) and is analyzed as previously discussed with respect to those claims.



Claim 27 contains the limitations of claims 11 and 23 (wherein the “information” is encoded in digital form within the television signal or “provided in a digital broadcast program” (See Jones col. 3 lines 42-57)) and is analyzed as previously discussed with respect to those claims.

Claim 28 contains the limitations of claims 11 and 24 (wherein the “information” is encoded in digital form within the television signal or “provided in a digital broadcast program” (See Jones col. 3 lines 42-57)) and is analyzed as previously discussed with respect to those claims.

Claim 35 contains the limitations of claims 15 and 23 and is analyzed as previously discussed with respect to those claims.

Claim 36 contains the limitations of claims 15 and 24 and is analyzed as previously discussed with respect to those claims.

Claim 37 contains the limitations of claim 1 and 23 (wherein the system performs the method) and is analyzed as previously discussed with respect to those claims.

Claim 38 contains the limitations of claim 3 and 24 (wherein the system performs the method) and is analyzed as previously discussed with respect to those claims.

Claim 39 contains the limitations of claims 25 and 37 (wherein the “information” is encoded in digital form within the television signal or “provided in a digital broadcast program” (See Jones col. 3 lines 42-57)) and is analyzed as previously discussed with respect to those claims.

Claim 40 contains the limitations of claims 26 and 38 (wherein the “information” is encoded in digital form within the television signal or “provided in a digital broadcast

program" (See Jones col. 3 lines 42-57)) and is analyzed as previously discussed with respect to those claims.

Claim 41 contains the limitations of claims 27 and 37 (wherein the "information" is encoded in digital form within the television signal or "provided in a digital broadcast program" (See Jones col. 3 lines 42-57)) and is analyzed as previously discussed with respect to those claims.

Claim 42 contains the limitations of claims 28 and 38 (wherein the "information" is encoded in digital form within the television signal or "provided in a digital broadcast program" (See Jones col. 3 lines 42-57)) and is analyzed as previously discussed with respect to those claims.

Claim 49 contains the limitations of claims 35 and 37 and is analyzed as previously discussed with respect to those claims.

Claim 50 contains the limitations of claims 36 and 38 and is analyzed as previously discussed with respect to those claims.

Claims 29-34 and 43-48 rejected under 35 U.S.C. 103(a) as being unpatentable over Jones et al. (US005978013A) in view of Tanaka et al. (US006588012B2) as applied to claims 1-14, 15-28, 35-42, 49, and 50 above, and further in view of Mori (US006089765A).

Regarding claim 29, Jones in view of Tanaka does disclose "information" that is encoded in digital form within the television signal or "provided in a digital broadcast program" (See Jones col. 3 lines 42-57). However, Jones in view of Tanaka does not

disclose that the supplemental data is transmitted as (1) "a header and a main body" and (2) the "header indicates whether or not print-output of the information is permitted, and wherein said judgment means of receiving apparatus reads header and judges whether or not the extracted information is information without print permission".

(1) Official Notice is taken that it is well known to transmit data in the form of packets, where the packets include a "header and a main body". Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify the "transmitting apparatus" disclosed by Jones in view of Tanaka to transmit supplemental data as packets that include a "header and a main body" in order to conform to a well known standard thereby increasing the compatibility of the system.

(2) Mori discloses a print system within a network where a computer adds data to the header of print data indicating whether printing the data is allowed or not or a "header indicates whether or not print-output of the information is permitted". The printer inherently reads the header and judges whether to print the data or not or "receiving apparatus reads header and judges whether or not the extracted information is information without print permission" (See Fig. 4; column 12 lines 7-25). Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify the supplemental data, digital broadcast receiving apparatus, and printer disclosed by Jones in view of Tanaka to have a "header that indicates whether or not print-output of the information is permitted, and the receiving apparatus reads header and judges whether or not the extracted information is information without print permission", as taught by Mori, in order to increase the efficiency of the system by

providing a standard location for printing instructions thereby making it easier to locate and to prevent multiple printed copies.

Claim 30 contains the limitations of claims 26 and 29 and is analyzed as previously discussed with respect to those claims.

Claim 31 contains the limitations of claims 27 and 29 and is analyzed as previously discussed with respect to those claims.

Claim 32 contains the limitations of claims 28 and 31 (wherein the “information” is encoded in digital form within the television signal or “provided in a digital broadcast program” (See Jones col. 3 lines 42-57)) and is analyzed as previously discussed with respect to those claims.

Claim 33 contains the limitations of claims 11, 27, and 29 and is analyzed as previously discussed with respect to those claims. However, Jones in view of Tanaka and further in view of Mori does not disclose that the “main body” of the supplemental data includes a “plurality of blocks”.

Official Notice is taken that it is well known that packets can include multiple blocks of data or a “plurality of blocks”, where each block represents different data, i.e. multiple coupon data from various sources. Therefore, it would be obvious to one with ordinary skill in the art at the time the invention was made to modify the supplemental data disclosed by Jones in view of Tanaka and in further view of Mori to have a “main body comprising a plurality of blocks”, where each block represents different data, in order to increase the transfer rate of the supplemental data by increasing the payload of each packet.

Furthermore, each “block” represents different data, i.e. different coupon data. Inherently each block would have a header identifying each data, i.e. coupon data, where each header includes printing instructions or “including blocks of information part without permission and blocks of the another information part” as taught by Mori above. The printer inherently reads the header and judges whether to print the data or not or “receiving apparatus reads header of block and judges whether or not print-output of the block is permitted”.

Claim 34 contains the limitations of claims 28 and 33 and is analyzed as previously discussed with respect to those claims.

Claim 43 contains the limitations of claims 29 and 39 and is analyzed as previously discussed with respect to those claims.

Claim 44 contains the limitations of claims 30 and 40 (wherein the “information” is encoded in digital form within the television signal or “provided in a digital broadcast program” (See Jones col. 3 lines 42-57)) and is analyzed as previously discussed with respect to those claims.

Claim 45 contains the limitations of claims 31 and 41 (wherein the “information” is encoded in digital form within the television signal or “provided in a digital broadcast program” (See Jones col. 3 lines 42-57)) and is analyzed as previously discussed with respect to those claims.

Claim 46 contains the limitations of claims 32 and 42 (wherein the “information” is encoded in digital form within the television signal or “provided in a digital broadcast

program” (See Jones col. 3 lines 42-57)) and is analyzed as previously discussed with respect to those claims.

Claim 47 contains the limitations of claims 33 and 41 and is analyzed as previously discussed with respect to those claims.

Claim 48 contains the limitations of claims 34 and 42 and is analyzed as previously discussed with respect to those claims.

### ***Response to Arguments***

3. Applicant's arguments with respect to claims 1-50 have been considered but are moot in view of the new ground(s) of rejection.

Furthermore, applicant argues with respect to Tanaka that the topic indicates the whole program and does not indicate a partial content provided in a program. However, Tanaka was introduced to show that one could reserve/schedule a television program that contains the topic or “partial content” requested by the user in advance. It is well known that topics are one of many different contents in programs. The program contents could also include actors, hosts, guest stars, etc.

Applicant is reminded that although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

**Conclusion**


4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph G. Ustaris whose telephone number is 571-272-7383. The examiner can normally be reached on M-F 7:30-5PM; Alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher S. Kelley can be reached on 571-272-7331. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



JGU  
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